REMARKS

In response to the final Office Action of March 18, 2009 and the Advisory Action of July 22, 2009, applicants request that all claims be allowed in view of the amendments to the claims and the following remarks. Claims 36-42, 44-50, 52-62, 64-66, 68-77, and 79-83 are pending in the application, with claims 36, 48, 56, 64, 68, 69, and 82 being independent.

Request for Entry of Amendment

Applicants have amended independent claims 36, 48, 56, 64, 68, 69, and 82 to incorporate previously pending dependent claims 90-96, respectively. In view of the fact that previously pending dependent claims 90-96 depended from independent claims 36, 48, 56, 64, 68, 69, and 82, respectively, applicants submit that the amendments to independent claims 36, 48, 56, 64, 68, 69, and 82 do not raise any new issues. Accordingly, applicants request entry of the amendments to the claims.

Claim Rejections Under 35 U.S.C. § 103

The final Office Action rejected dependent claims 90-96 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,212,548 (DeSimone), U.S. Patent No. 6,748,421 (Ozkan), U.S. Patent No. 7,233,992 (Muldoon), and U.S. Patent No. 6,795,863 (Doty). However, as discussed in applicants' June 17, 2009 Reply, the combination of DeSimone, Ozkan, Muldoon, and Doty does not render previously pending dependent claims 90-96 obvious. Consequently, in hopes of advancing prosecution, applicants have canceled claims 90-96 and have amended each of independent claims 36, 48, 56, 64, 68, 69, and 82 to incorporate the features of previously pending dependent claims 90-96.

Accordingly, applicants request that prosecution be reopened in view of the amendments to independent claims 36, 48, 56, 64, 68, 69, and 82. Alternatively, in the event that prosecution is not reopened in view of the amendments to independent claims 36, 48, 56, 64, 68, 69, and 82, applicants have provided the remarks below in the hopes of eliciting a meaningful response to the amendments to the claims in order to clarify any unresolved issues for appeal.

As amended, independent claim 36 recites, among other features, determining if a recipient is capable of participating in video instant messaging in response to initiating a text instant messaging session between a sender and the recipient and enabling a graphical user interface displayed to the sender to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging.

The final Office Action acknowledges that DeSimone, Ozkan, and Muldoon fail to describe or suggest these features. Final Office Action of March 18, 2009 at page 16, lines 10-15. Therefore, the final Office Action relies on Doty for teaching these features.

Doty teaches a system that streams video to an e-mail recipient using a web-based e-mail application. *See e.g.*, Doty at Abstract. As described by Doty, Doty's system displays the video streamed to the e-mail recipient in the same web page through which the e-mail recipient sends and receives e-mails using the web-based e-mail application. *See e.g.*, Doty at Abstract and FIG. 4. As further described by Doty, before video is streamed to the e-mail recipient, Doty's system determines certain capabilities of the e-mail recipient's computer and then streams the video to the e-mail recipient in a format and at a bit-rate that are determined to be appropriate based upon the determined capabilities of the e-mail recipient's computer. *See, e.g.*, Doty at col. 8, line 45 to col. 9, line 4.

Notably, Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail recipient by an organization that is responsible for producing and streaming video to e-mail users, not by other users who have sent e-mails to the e-mail recipient. *See* Doty at col. 10, lines 33 to col. 12, line 43. Because Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail user by an organization that is independent from and unrelated to users who have sent e-mails to the e-mail recipient, Doty does not describe or suggest determining if the e-mail recipient is capable of participating in video messaging *in response to initiating a communications session between the e-mail recipient and an e-mail user who has or is going to send an e-mail to the e-mail recipient.* Furthermore, because Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail user by an organization that is independent from and unrelated to users who have sent e-mails to the e-mail recipient, it is not surprising that Doty does not describe or suggest

indicating any of the e-mail recipient's capabilities, let alone the e-mail recipient's capability to engage in video messaging, to an e-mail user who has or is going to send an e-mail to the e-mail recipient.

Thus, even when Doty's teachings are combined with those of DeSimone, Ozkan, and Muldoon, the combination does not describe or suggest determining if a recipient is capable of participating in video instant messaging in response to initiating a text instant messaging session between a sender and the recipient and enabling a graphical user interface displayed to the sender to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging, as recited in amended independent claim 36. Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claim 36.

Each of independent claims 48, 56, 64, 68, 69, and 82 has been amended to recite features that are similar to those recited in amended independent claim 36 and discussed above. Accordingly, applicants request reconsideration and withdrawal of the rejection of independent claims 48, 56, 64, 68, 69, and 82 for at least the reasons discussed above in connection with independent claim 36.

Dependent claims 37, 38, 49, 50, 57, 58, 65, 66, 70-71 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone in view of Ozkan and Muldoon. Dependent claims 39-42 and 59-62 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone, Ozkan, Muldoon and Doty. Dependent claims 44-47 and 52-55 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone, Ozkan, and Muldoon in view of U.S. Patent No. 6,529,475 (Wan). Dependent claim 83 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone, Ozkan, and Muldoon in view of U.S. Patent No. 6,223,213 (Cleron).

Wan and Cleron, when taken alone or in combination, do not cure the deficiencies of the combination of DeSimone, Ozkan, Muldoon, and Doty noted above in connection with independent claims 36, 48, 56, 64, 68, 69, and 82. Accordingly, applicants request reconsideration and withdrawal of the rejection of dependent claims 37-42, 44-47, 49, 50, 52-55, 57-62, 65, 66, 70-77, and 83 at least because of their dependencies and for the reasons discussed above in connection with independent claims 36, 48, 56, 64, 68, 69, and 82.

Conclusion

Applicants submit that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any charges or credits due in connection with the filing of this Amendment or otherwise to Deposit Account 06-1050.

Respectfully submitted,

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